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TECHNOLOGY CENTER 3600

James J. Ralabate
5792 Main Street
Williamsville, NY 14221

In re Application of
Robert A. Clark
Application No. 10/815,142
Filed: March 31, 2004
For: SUBSTRATE BENDING
STIFFNESS MEASUREMENT
METHOD AND SYSTEM

:
: DECISION ON PETITION
: UNDER 37 CFR §1.181
:
:

This is a decision on the petition under 37 CFR 1.181 filed May 9, 2006, for the entry of claims 5 and 6 as filed on April 12, 2006 and the Removal of the Notice of Non-Responsive Amendment sent by the Primary Examiner on April 26, 2006.

The petition is **GRANTED**.

This application was filed March 31, 2004 and included claims 1-4 directed toward a "method of feeding". On April 12, 2006, in response to a non-final rejection, the Petitioner submitted an amendment canceling claims 1-4 and adding new claims 5 and 6 directed to a "method for real time measuring". On April 26, 2006, the examiner held the amendment "non-responsive" because the newly submitted claims were directed to an invention independent or distinct from the invention originally claimed. On May 9, 2006, the Petitioner filed this Petition as well as a substitute amendment canceling the originally filed claims 1-4, restating claims 5 and 6 directed to a "method for real time measuring" as they were previously submitted, and adding claims 7 and 8 directed to an "apparatus for real time measuring".

The Petitioner contends that claims 5 and 6 filed April 12, 2006 merely addressed the examiner's objection to ambiguities in the original method claims. The Petitioner also states that claims 5 and 6 better distinguish over previously cited references.

M.P.E.P. § 814 states that the examiner must provide a clear and detailed record of a restriction requirement. M.P.E.P. § 817 provides an outline for the examiner to use when setting forth a requirement to restrict. A review of the Notice of Non-

Responsive Amendment demonstrates that the examiner did not follow the outline presented in M.P.E.P. § 817 for a Letter for Restriction Requirement in communicating the examiner's reasons for restriction. Therefore, the examiner's reasons for restriction were not clearly communicated to Petitioner.

In view of the finding above, the Notice of Non-Responsive Amendment mailed April 26, 2006 is VACATED. Accordingly, the application will be returned to the examiner to continue prosecution. The substitute amendment filed on May 9, 2006 including claims 5-8 will be entered. If the examiner determines that a requirement for restriction should be made in this application, the examiner must provide a clear and detailed record of the requirement by following the outline of Letter for Restriction Requirement provided in M.P.E.P. § 817.

This application is being forwarded to the examiner of record.

Any questions regarding this letter should be directed to Patrick Mackey at (571) 272-6916.


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